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| EXAMINER | |
|---|---|
| KARIKARI, KWASI | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/774,809 | FORNELL, PETER | |
| | Examiner | Art Unit | |
| | KWASI KARIKARI | 2617 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### Response to Arguments

1. Applicant's arguments, filed on 01/30/2009 with respect to claims 1-20 in the remarks, have been considered but are moot in view of the new ground(s) of rejection necessitated by the new limitations added to claims. See the rejection below of the pending claims for relevant citations found in Oshima disclosing the newly added limitations.

### Claim Objections

2. Applicant recites "comprises at least one of of" in claim 20. Appropriate collections are required.

### Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3, 6-7,9-17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Oshima (U.S. 6,463,300), (hereinafter Oshima).**

**Regarding claims 1 and 11**, Oshima discloses method/device of configuring a mobile device in a mobile communications network, the method comprising (=SIM card stores

an IMSI number and a PIN number; and the CPU collates a PIN number stored in the SIM card with a secret number inputted by a user of the mobile station 10, see col. 7, lines 25-30; and col. 8, lines 1-21) the method comprising:

determining whether a first identity module coupled to the mobile device is different from a second identity module previously coupled to the mobile device (= mobile station 10 identifies whether or not the inserted SIM card 26 is equal to the previously inserted SIM card 26, see col. 7, lines 35-37 and Fig. 6; whereby the Sim card 26 is being associated with the "first identity module" and the previous Sim card is also being associated with the "second identity module");

searching a data structure external (= memory section 25 has a SIM data storing section 252 storing a part of various data storing in the SIM card 26 inserted into the mobile station 10, see col. 6, lines 28-34; and col. 7, lines 35-50) to the first identity module for first configuration data (= IMSI, PIN and telephone number a short dial data; and controller obtain data from the inserted card and make judgment, see col.6, lines 35-48; and col. 7, lines 25-35) associated with the first identity module in response to determining the first identity module is different from the second identity module, (= various data storing in the SIM card 26 that are stored in the memory section 25 of the mobile station 10, is use to compare with the obtained data so as to judge whether the obtained data is the same as previously stored data in the mobile station 10, see col. 6, lines 28-41); and

automatically configuring the mobile device to use the first configuration data to operate in the mobile communications network (see col. 7, lines 35-50), in response to

finding the first configuration data in the data structure (= phone can connect the network when stored data 254 is equal to the minimum data and the controller 21 recognizes that the attached SIM card 26 is not changed; and PIN number is equal to the inputted number, see col. 9, line 39- col. 10, line 46; and S02, S03, S11-S14).

**Regarding claim 2**, Oshima discloses the method of claim 1, further comprising: prompting entry of the first configuration data, in response to failing to find the first configuration data in the data structure (= controller requests a user to input a secret number if the inserted SIM card 26 is different from the previously inserted SIM card 26, see col. 6, lines 42-48; and using data storing in section 252 to comparing if the inserted card is the same as the previous inserted Sim card 26, see col. 6, lines 21-55).

**Regarding claim 3**, Oshima discloses the method of claim 2, further comprising:

storing the first configuration data in a first entry in the data structure, in response to receiving the first configuration data (= data and at least one pair of address are stored in the sim card 26, see col. 6, lines 21-41).

**Regarding claim 6**, Oshima discloses the method of claim 1, wherein the data structure is stored in the mobile device (= various data stored on sim card are store in the memory section 25 of the mobile station 10, see, col. 6, lines 21-41).

**Regarding claim 7,** as recited in claim 1, Oshima discloses that the data structure is stored in a communications network component accessible by the mobile device (see, col. 6, lines 21-41).

**Regarding claim 9,** as recited in claim 1, Oshima discloses the method wherein the determining comprises: identifying the first identity module based on a first unique value embedded in the first identity module (= mobile station 10 identifies whether or not the inserted SIM card 26 is equal to the previously inserted SIM card 26, see col. 7, lines 35-37 and Fig. 6; whereby the Sim card 26 is being associated with the "first identity module" and the previous Sim card is also being associated with the "second identity module");; and comparing the first unique value with a second unique value embedded in the second identity module (= IMSI, PIN and telephone number a short dial data, and controller obtain data from the inserted card and make judgment, see col.6, lines 35-48; and col. 7, lines 25-35), wherein the first identity module is different from the second identity module if the first unique value and the second unique value do not match (= network access depends on whether an IC card attached to the mobile terminal differ from a previously inserted card, see col. 3, lines 29-36 and storing section 252 stores address and corresponding data, the controller reads data from the storing section to determine whether SIM card 26 has been exchanged from the mobile terminal, see col. 7, lines 35-62; which inherently suggest the mobile terminal could store plurality of IC cards data for subsequent data comparison).

**Regarding claim 10**, as recited in claim 1, Oshima discloses the method wherein the first unique value comprises at least one of a serial number of the first identity module or a network ID associated with the firs identity (= IMSI, PIN and telephone number a short dial data, and controller obtain data from the inserted card and make judgment, see col.6, lines 35-48; and col. 7, lines 25-35).

**Regarding claim 12**, as cited in claim 11, Oshima discloses the mobile device further comprising a logic unit for prompting entry of the first configuration data, in response to failing to find the first configuration data in the data structure (= controller requests a user to input a secret number if the inserted SIM card 26 is different from the previously inserted SIM card 26, see col. 6, lines 42-48; and using data storing in section 252 to comparing if the inserted card is the same as the previous inserted Sim card 26, see col. 6, lines 21-55).

**Regarding claim 13,** as recited in claim 12, Oshima discloses further comprising a logic unit for storing the first configuration data in a first entry in the data structure, in response to receiving said first configuration data (see col. 7, line 35- col. 8, line 38).

**Regarding claim 14**, Oshima further teaches the mobile device of claim 13, further comprising: a logic unit for storing a reference to the first identity module in a second entry in the data structure (see col. 7, lines 25-67); and a logic unit for associating the first entry with the second entry such that, if the first identity module is recoupled to the

mobile device after being removed, the reference in the second entry is used to access the first configuration data stored in the first entry (= inserted Sim card 26 and comparing secret number, see col. 6, lines 21-55).

**Regarding claim 15**, Oshima discloses the mobile device of claim 14, wherein the data structure comprises a plurality of associated entries for coupling a plurality of identity modules using respective configuration data (= SIM card 26 stores IMSI number, a PIN number, a telephone of a subscriber, and a short dial data registered by user, see col. 7, lines 25-30 and lines 45-67).

**Regarding claim 16**, Oshima discloses the mobile device of claim 11, wherein the data structure is stored in the mobile device (= various data stored on sim card are store in the memory section 25 of the mobile station 10, see, col. 6, lines 21-41).

**Regarding claim 17,** as recited in claim 11, Oshima discloses that the data structure is stored in a communications network component accessible by the mobile device (see, col. 6, lines 21-41).

**Regarding claim 19,** as recited in claim 11, Oshima discloses the device wherein the determining comprises: identifying the first identity module based on a first unique value embedded in the first identity module (= mobile station 10 identifies whether or not the inserted SIM card 26 is equal to the previously inserted SIM card 26, see col. 7, lines

35-37 and Fig. 6; whereby the Sim card 26 is being associated with the "first identity module" and the previous Sim card is also being associated with the "second identity module");; and comparing the first unique value with a second unique value embedded in the second identity module (= IMSI, PIN and telephone number a short dial data, and controller obtain data from the inserted card and make judgment, see col.6, lines 35-48; and col. 7, lines 25-35), wherein the first identity module is different from the second identity module if the first unique value and the second unique value do not match (= network access depends on whether an IC card attached to the mobile terminal differ from a previously inserted card, see col. 3, lines 29-36 and storing section 252 stores address and corresponding data, the controller reads data from the storing section to determine whether SIM card 26 has been exchanged from the mobile terminal, see col. 7, lines 35-62; which inherently suggest the mobile terminal could store plurality of IC cards data for subsequent data comparison).

**Regarding claim 20**, as recited in claim 19, Oshima discloses the mobile device wherein the first unique value comprises at least one of a serial number of the first identity module or a network ID associated with the first identity module (= IMSI, PIN and telephone number a short dial data, and controller obtain data from the inserted card and make judgment, see col.6, lines 35-48; and col. 7, lines 25-35).

**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> The factual inquiries set forth in *Graham* **v.** *John Deere* Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
>
> 1. Determining the scope and contents of the prior art.
> 2. Ascertaining the differences between the prior art and the claims at issue.
> 3. Resolving the level of ordinary skill in the pertinent art.
> 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 4-5, 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima in view of Lee (U.S. 20040195313 A1), (hereinafter Lee).**

**Regarding claim 4**, as recited in claim 3, **Oshima f**ails to teach storing a reference to the first identity module in a second entry in the data structure, and associating the first entry with the second entry, such that, if the first identity module is recoupled to the mobile device after being removed, the reference in the second entry is used to access the first configuration data stored in the first entry.

**Lee** equivalently teaches storing a reference (= newly system network set-up information, see Par [0011]) to the first identity module in a second entry in the data structure, and associating the first entry with the second entry, such that if the first identity module is recoupled to the mobile device after being removed, the reference in the second entry is used to access the first configuration data stored in the first entry (=

newly system network set-up information, is received, stored, compared to the existing data and update the difference, see Par [0011] and Fig. 4).

It would therefore have been obvious to one of the ordinary skill in the art combine the teaching of Lee into the system of Oshima for the benefit of achieving a system whereby network set-up information for a mobile station could be obtained through a service provider.

**Regarding claim 5**, **Oshima** further discloses the method of claim 4, wherein the data structure comprises a plurality of associated entries for coupling a plurality of identity modules using respective configuration data (= SIM card 26 stores IMSI number, a PIN number, a telephone of a subscriber, and a short dial data registered by user, see col. 7, lines 25-30 and lines 45-67).

**Regarding claim 8** as recited in claim 1, **Oshima** fails to teach the first configuration data comprises at least one of a mobile communication network access point name (APN) or wireless application protocol internet protocol (WAP IP) address.

However, **Lee** equivalently teaches the first configuration data comprises at least one of a mobile communication network access point name (APN) or wireless application protocol internet protocol (WAP IP) address (= network set-up information includes Wireless application Protocol (WAP) gateway address, and a WAP access point name, see Par. [0024] and Fig. 4).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Lee into the system of Oshima for the benefit of achieving a system whereby network set-up information for a mobile station could be obtained through a service provider.

**Regarding claim 18** as recited in claim 11, **Oshima** fails to teach the first configuration data comprises at least one of a mobile communication network access point name (APN) or wireless application protocol internet protocol (WAP IP) address.

However, **Lee** equivalently teaches the first configuration data comprises at least one of a mobile communication network access point name (APN) or wireless application protocol internet protocol (WAP IP) address (= network set-up information includes Wireless application Protocol (WAP) gateway address, and a WAP access point name, see Par. [0024] and Fig. 4).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Lee into the system of Oshima for the benefit of achieving a system whereby network set-up information for a mobile station could be obtained through a service provider.

## CONCLUSION

**Examiner's Note**: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to

specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. **SEE MPEP 2141.02 [R-5] VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS**: A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). >See also MPEP §2123.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of 33the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (9am - 7pm).
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566.
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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